



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,754	09/29/2003	Ifedayo Udiani	39576	1464
59241 7590 11/17/2008 LATIMER, MAYBERRY & MATTHEWS IP LAW, LLP 13873 PARK CENTER ROAD SUITE 106 HERNDON, VA 20171				
EXAMINER				
GREGG, MARY M				
ART UNIT		PAPER NUMBER		
3694				
MAIL DATE		DELIVERY MODE		
11/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/673,754

Applicant(s)

UDIANI, IFEDAYO

Examiner

MARY GREGG

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,6,8-13,15-17,19,20 and 22-28 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 5,6,8-13,15-17,19,20 and 22-28 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

MMG

DETAILED ACTION

1. The following is a Non-Final Office Action in response to communications received October 1, 2008. Claims 1-4, 7, 14, 18 and 21 have been canceled. Claims 5-6, 8-9, 11-13, 15, 19-20 and 22 have been amended. Claims 26-28 have been added. Therefore, claims 5-6, 8-13, 15-17, 19-20 and 22-28 are pending and addressed below.

Response to Amendment

Claim Rejections - 35 USC § 112

2. In reference to Claim 12, applicant's amendments to the claims are sufficient to overcome the 35 USC 112, 1st paragraph rejection. The examiner withdraws the rejection.

In reference to Claim 5, applicant's amendments to the claims are sufficient to overcome the 35 USC 112, 2nd paragraph rejection. The examiner withdraws the rejection.

Claim Rejections - 35 USC § 101

3. In reference to Claim 12, applicant's amendments to the claims are sufficient to overcome the 35 USC 101 rejection. The examiner withdraws the rejection.

Claim Rejections - 35 USC § 103

4. In reference to Claims 5-11 and 13-24 applicants' amendments to the claims are sufficient to overcome the 35 USC 103 rejection of Webster in view of Official Notice.

The examiner withdraws the rejection, see rejection below

In reference to Claim 12 applicant's amendments to the claims are sufficient to overcome the 35 USC 103 rejection of Webster in view of Official Notice and further in

view of "Sales Tax Compliance Software" by CCH. The examiner withdraws the rejection, see rejection below.

5. In reference to Claim 25 applicant's amendments to the claims are sufficient to overcome the 35 USC 103 rejection of Webster in view of Official Notice and further in view of Ferrier. The examiner withdraws the rejection, see rejection below.

Response to Arguments

6. In response to applicant's arguments with respect to the 35 USC 101 rejection for claims 5-25, the applicant's arguments were persuasive. The examiner withdraws the rejection.

Applicant's arguments with respect to claims 5-25 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

7. Claims 15-17 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In reference to Claims 15, 16 and 17:

Claims 15-17 depend upon claim 13 which directed toward the statutory category of a system. However, claims 15-17 are directed toward non-functional data and do not further limit the structure or function of the system. Appropriate correction is required

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5-6, 10-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub No. 2002/0055911 A1 by Guerreri (Gue), and further in view of US Pub No. 2002/0026418 A1 by Koppel et al. (Kop).

In reference to Claim 5:

Gue teaches:

(Currently Amended) A method of making payment over the internet comprising:

a. electronically crediting positive value from at least one ...into a first account to create a user account balance, wherein said first account is an individual user e-account with a third party institution ((Gue)FIG. 3; para 0024 lines 2-4, 11-16, para 0028 lines 1-5, para 0030), and wherein said electronically crediting positive value is performed by a user online at any time without disclosing a user's confidential information ((Gue) FIG. 3; para 0024 lines 2-4, 11-16, para 0030)

b. electronically debiting positive value from said first account in an amount less than or equal to said user account balance without disclosing a user's confidential information ((Gue) para 0030, para 0031, para 0033 lines 11-14, para 0037 lines 7-10, para 0037 lines 15-17), and...

Gue does not explicitly teach:

...pre-paid smart card... c. electronically crediting at least a portion of said positive value to a second account without disclosing a user's confidential information
Kop teaches:

...pre-paid smart card ((Kop) para 0011, para 0018)... c. electronically crediting at least a portion of said positive value to a second account without disclosing a user's confidential information ((Kop) FIG. 9; para 0052, para 0053, para 0054).

With respect to the "pre-paid smart card", both Gue and Kop are directed toward the buyers debit cards and electronic accounts set up in a third party account ((Kop) FIG. 1; para 0038 lines 5-18, (Gue) ((Gue) para 0030, para 0031, para 0033 lines 11-14, para 0037 lines 7-10, para 0037 lines 15-17) Kop teaches away from a "smart card" because merchants must have special equipment for such a card. Kop teaches an alternative by creating a pre-paid card by prepaying the issuer of the card. The motive of Kop is to create a card to protect the identity and information of the user. Gue teaches explicitly creating online accounts for each prepaid card ((Gue) para 0024 lines 11-12) with the cards being purchased from a card issuer, organization or store ((Gue) para 0024 lines 12-15). Therefore, Gue is also teaching purchase of a prepaid card that does not require purchaser information to provide funds for e-accounts. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute comparable pre-paid cards such as the pre-paid smart card, the anonymous prepaid card as taught by Kop with the store or organization card taught by Gue.

With respect to the limitation, electronically crediting at least a portion of said positive value to a second account without disclosing a user's confidential information.

Both Gue and Kop are explicitly directed toward anonymity for the purchaser for on-line purchases. Gue teaches an e-account whose account is depleted ((Gue) para 0031), Gue teaches the motivation for electronic accounts that can be redeemed, cashed in or rolled into another account when an account is has too little value for purchases ((Kop) para 0052). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Gue with Kop in order to redeem accounts that have too little value for additional purchases.

In reference to Claim 6:

The combination Gue and Kop teach:

(Currently Amended) The payment method according to claim 5 (see rejection of claim 5 above) further comprising increasing said user account balance by electronically crediting said first account with additional positive value from at least one pre-paid smart card without disclosing a user's confidential information ((Gue) para 0024 lines 3-16, para 0031, (Gue) para 0053, para 0055 lines 5-10)

Although, Gue teaches making deposits into the online account via credit card or bank account, Gue teaches setting up the account with a pre-paid card. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to simply substitute one element (prepaid) for another (credit card) to achieve predictable results.

In reference to Claim 10:

The combination teaches:

(Previously Presented) The payment method according to claim 5 (see rejection of claim 5 above), wherein said positive value is an internet standard of value ((Gue) para 0031 lines 1-3, (Kop) para 0050, para 0051).

In reference to Claim 11:

The combination teaches:

(Currently Amended) The payment method according to claim 5 (see rejection of claim above), wherein said electronically debiting and electronically crediting are performed for purchasing ((Gue) para 0030 lines 5-9, (Kop) para 0039 lines 10-14, para 0040 lines 1-2) e-stamps.

Note: The mere recitation of merits and advantages of a use of a product without method steps directed toward an invention is non-functional descriptive subject matter

In reference to Claim 13:

Gue teaches:

(Currently Amended) An e-commerce payment system comprising:

...b. a first account for electronically depositing at least a portion of said positive value from said at one pre-paid...card ((Gue) FIG. 3; para 0024 lines 11-16, para 0028 lines 3-5), wherein said first account is a first individual user e-account hosted on a third party institution's server ((Gue) FIG. 1, FIG. 2, FIG. 3), and wherein said electronically depositing at least a portion of said positive value is performed by a user online at any time without disclosing a user's confidential information ((Gue)) FIG. 1, FIG. 2, FIG. 3; para 0024 lines 2-4, 11-16, para 0030)... without disclosing a user's confidential information ((Gue) FIG. 1, FIG. 2, FIG. 3; para 0024 lines 2-4, 11-16, para 0030)

Gue does not explicitly teach:

...a. at least one pre-paid smart card comprising positive value, ... least one pre-paid smart card ... c. a second account for electronically depositing at least a portion of said positive value from said first account, wherein said second account is a merchant account or second individual user e-account on or linked to said third party institution's server

Kop teaches:

...a. at least one pre-paid smart card comprising positive value, ... least one pre-paid smart card ... ((Kop) FIG. 1, FIG. 2, FIG. 3, FIG. 4, FIG. 8, FIG. 10; para 0011, para 0018)...c. a second account for electronically depositing at least a portion of said positive value from said first account, wherein said second account is a merchant account or second individual user e-account on or linked to said third party institution's server without disclosing a user's confidential information ((Gue) FIG. 8, FIG. 9; para 0051, para 0052 lines 1-3)

With respect to the "pre-paid smart card", both Gue and Kop are directed toward the buyers debit cards and electronic accounts set up in a third party account ((Kop) FIG. 1; para 0038 lines 5-18, (Gue) ((Gue) para 0030, para 0031, para 0033 lines 11-14, para 0037 lines 7-10, para 0037 lines 15-17) Kop teaches away from a "smart card" because merchants must have special equipment for such a card. Kop teaches an alternative by creating a pre-paid card by prepaying the issuer of the card. The motive of Kop is to create a card to protect the identity and information of the user. Gue teaches explicitly creating online accounts for each prepaid card ((Gue) para 0024 lines

11-12) with the cards being purchased from a card issuer, organization or store ((Gue) para 0024 lines 12-15). Therefore, Gue is also teaching purchase of a prepaid card that does not require purchaser information to provide funds for e-accounts. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute comparable pre-paid cards such as the pre-paid smart card, the anonymous prepaid card as taught by Kop with the store or organization card taught by Gue.

With respect to the limitation, electronically crediting at least a portion of said positive value to a second account without disclosing a user's confidential information. Both Gue and Kop are explicitly directed toward anonymity for the purchaser for on-line purchases. Gue teaches an e-account whose account is depleted ((Gue) para 0031), Gue teaches the motivation for electronic accounts that can be redeemed, cashed in or rolled into another account when an account is has too little value for purchases ((Kop) para 0052). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Gue with Kop in order to redeem accounts that have too little value for additional purchases.

10. Claims 8-9, 12, 15-17, 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub No. 2002/0055911 A1 by Guerreri (Gue), and in view of US Pub No. 2002/0026418 A1 by Koppel et al. (Kop) as applied to claim 5 above with respect to claims 8-9 and 12, as applied to claim 13 above with respect to claims 15-17 and 19, as applied to claims 5 and 6 with respect to claim 28, and further in view of Official notice.

In reference to Claim 8:

The combination, Gue and Kop, teaches:

(Currently Amended) The payment method according to claim 5 (see rejection of claim 5 above), wherein said user's confidential information is personal or financial information.

Official Notice is taken that it is old and well known the user's confidential information encompasses personal and financial information. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention that the prior art when referring to user anonymity with respect to user information is referring to the users financial and personal information.

In reference to Claim 9:

The combination Gue, Kop and Official Notice teach:

(Currently Amended) The payment method according to claim 8, wherein said user's confidential information is bank account, credit card, birth date, or social security number information

Official Notice is taken that it is old and well known the user's confidential information encompasses bank account information, credit card information, birth dates and social security numbers. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention that the prior art when referring to user anonymity with respect to user information is referring to the users to details of the users financial and personal information.

In reference to Claim 12:

The combination Gue and Kop teach:

(Currently Amended) The payment method according to claim 5 (see rejection of claim above), wherein said at least a portion of said positive value includes an amount for taxes

Official Notice is taken that it is old and well known for transaction payment to be sufficient to provide funds for the goods and for the taxes required on those goods. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for the combination to include the tax payments required in the payment of the goods.

In reference to Claim 15:

The system of Claim 15 corresponds to the method of Claim 8, therefore, system of Claim 15 has been analyzed and rejected as per previously discussed with respect to Claim 8.

In reference to Claim 16:

The system of Claim 16 corresponds to the method of Claim 9, therefore, system of Claim 16 has been analyzed and rejected as per previously discussed with respect to Claim 9.

In reference to Claim 17:

The system of Claim 17 corresponds to the method of Claim 10, therefore, system of Claim 17 has been analyzed and rejected as per previously discussed with respect to Claim 10.

In reference to Claim 19:

The combination Gue and Kop teach:

(Currently Amended) The e-commerce payment system according to claim 13 (see rejection of claim 13 above), wherein said merchant account or second individual user e-account is linked to said third party institution's server to electronically record debit and credit transactions between users and merchants((Gue) para 0031; (Kop) FIG. 6; para 0043 lines 10-15, para 0055 lines 7-12, para 0056)...

The combination does not teach explicitly:

...in real time

Official Notice is taken the recording of transaction with respect to crediting or debiting an account is old and well known. The combination teaches explicitly of recording, tracking and recharging or transferring balances based upon funds in accounts. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the old well known technique of tracking balances in real time.

In reference to Claim 28:

The method of Claim 28 corresponds to the method of Claim 8, therefore, the method of Claim 28 has been analyzed and rejected as per previously discussed with respect to Claim 8

11. Claims 20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub No. 2002/0055911 A1 by Guerreri (Gue), and in view of US Pub No. 2002/0026418 A1 by Koppel et al. (Kop) and further in view of US Pub No. 2004/0002918 A1 by McCarthy et al. (Mc).

In reference to Claim 20:

The method of Claim 20 corresponds to the method of Claim 5, therefore, the method of Claim 20 has been analyzed and rejected as per previously discussed with respect to Claim 5. The feature in claim 20 that is separate from claim 5 is:

d. electronically crediting a merchant or a second user e-account with said value debited without disclosing a user's confidential information

The combination Gue and Kop do not teach explicitly:

d. electronically crediting a merchant or a second user e-account with said value debited...

Mc teaches:

d. electronically crediting a merchant or a second user e-account with said value debited...((Mc) FIG. 4 para 0070).

Mc teaches the typical mode of payment and depositing funds into the merchant account after ensuring goods have been delivered before depositing funds into the merchants account. As both the combination and Mc are explicitly directed toward transactions in e-commerce (online), it would have been obvious to one of ordinary skill in the art at the time of the invention to apply a known technique to a known method ready for improvement to yield predictable results.

In reference to Claim 26:

The combination Gue, Kop and Mc teach:

(New) The payment method according to claim 20 (see rejection of claim 20 above) further comprising establishing a merchant e-account with a third party institution

((Mc) FIG. 4 para 0070; wherein the combination via Mc teaches the bank charges the account of the buyer and credits them to the merchant).

12. Claims 22-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub No. 2002/0055911 A1 by Guerreri (Gue), in view of US Pub No. 2002/0026418 A1 by Koppel et al. (Kop) and in view of US Pub No. 2004/0002918 A1 by McCarthy et al. (Mc), as applied to claim 20 above, and further in view of Official Notice.

In reference to Claim 22:

The method of Claim 22 corresponds to the method of Claim 8, therefore, the method of Claim 22 has been analyzed and rejected as per previously discussed with respect to Claim 8.

In reference to Claim 23:

The method of Claim 23 corresponds to the method of Claim 9, therefore, the method of Claim 23 has been analyzed and rejected as per previously discussed with respect to Claim 9.

In reference to Claim 24:

The method of Claim 24 corresponds to the method of Claim 10, therefore, the method of Claim 24 has been analyzed and rejected as per previously discussed with respect to Claim 10

In reference to Claim 25:

The combination teaches:

(Previously Presented) The payment method according to claim 20 (see rejection of claim 20 above), wherein a user accesses said e-account by log in through a merchant website using an e-mail address as a user name, a personal identification number ((Kop) para 0058, and a password ((Gue) para 0030, (Kop) para 0039).

Although the combination does not teach an email address as a user id, Official Notice is taken that it is well known in the art for sites to require user ID's and that email addresses are commonly used in that capacity. As the combination teach other forms of authorization and identification without disclosing information on the user it would have been obvious to one of ordinary skill in the art at the time of the invention to include a user id.

In reference to Claim 27:

(New) The payment method according to claim 26 (see rejection of claim 26 above), wherein a registered merchant electronically accesses said merchant e-account by log in through a third party institution's website using an e-mail address as a user name, a personal identification number, ((Kop) para 0058, and a password ((Gue) para 0030, (Kop) para 0039).

With respect to the merchant accessing the merchant account by logging into a third party institution website. The teachings of the combination explicitly teach the user logging into the users account. The feature in claim 27 is a nonfunctional descriptive nomenclature "merchant", the simple renaming of accounts does not require change in the method nor cause a change in the result.

Although the combination does not teach an email address as a user id, Official Notice is taken that it is well known in the art for sites to require user ID's and that email addresses are commonly used in that capacity. As the combination teach other forms of authorization and identification without disclosing information on the user it would have been obvious to one of ordinary skill in the art at the time of the invention to include a user id.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent No. 7,249,054 B2 by Keil is cited for teaching debit account transactions. US Pub No. 2001/0027439 A1 by Holtzman et al. is cited for being directed toward pre-paid smart cards used for transactions. US Patent No. 5,825,003 by Jennings et al. is cited for teaching transferring funds between accounts using a holding account. US Pub No. 2003/0212642 A1 by Weller et al. is cited for teaching online authentication methods and systems. US Pub No. 2002/0128977 A1 by Nambiar et al. is cited for teaching micro-chip online transactions. US Pub No. 2003/0205709 A1 by Orlando is cited for teaching internet immediate payment processing. US Patent No. 7,415,442 b1 by Battaaglini et al. is cited for teaching integrated money transfer system.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARY GREGG whose telephone number is (571)270-5050. The examiner can normally be reached on 4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 5712726712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. G./
Examiner, Art Unit 3694

/Mary Cheung/
Primary Examiner, Art Unit 3694